

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

Information Disclosure Statement

With regard to the Examiner's note that the listing of references in the specification is not a proper information disclosure statement (IDS), an IDS is submitted herewith including a form PTO-1449 listing these references. Applicant requests that the Examiner consider these references, and that these references be printed on the face of any application issuing from this application.

Rejection of claims 1-5 under 35 U.S.C. § 112, second paragraph

Claims 1-5 presently stand rejected as being indefinite, because it is unclear in claim 1 if the transitional phrase is intended to be open or closed, and because the term "or the like" in claim 1 is indefinite. Claim 1 has been amended to incorporate the originally intended transitional phrase "comprising", and to eliminate the term "or the like" from the preamble of the claim. It is respectfully submitted that the indefiniteness of claim 1 has been corrected. Withdrawal of the rejection is therefore respectfully requested.

The claims have been further amended to improve the grammatical structure and to make the terms of the claims consistent.

Rejection of claims 1-5 under 35 U.S.C. § 103(a)

Claims 1-5 presently stand rejected as unpatentable over Poppe (U.S. 4,194,255) in view of Contreras (U.S. 5,797,154) and Giori et al (U.S. 6,684,433). This rejection is respectfully traversed for the following reasons.

Poppe, Contreras, and Giori together fail to teach or suggest all the limitations of claim 1 of the present application. To establish prima facie obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "*All words in a claim* must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (emphasis added).

It is respectfully submitted that none of the cited references teach or suggest the use of foam wherein "at least a part of the cells present in the foam are broken open." The Examiner contends that this is taught by Poppe, and refers to Column 3, lines 8-62, along with Figures 1 and 2. However, the cited text says nothing about broken cells. In fact, the cited text is entirely silent on any description of the cells of the foam, and makes no mention of any desirability of breaking, or bursting, the foam cells. The cited Figures simply lack detail sufficient to teach or suggest any cell structure.

In contrast, the present application clearly describes that "the cells are broken open such that the foam obtains a more open structure and allows for a good air circulation." (Page 3, lines 11-17; Page 6, lines 5-10). Not only does the Poppe patent fail to teach or suggest the use of foam wherein "at least a part of the cells present in the foam are broken open," Poppe does not make any reference to such features as an open structure, enhanced air circulation, or any other altered characteristic resulting from broken cells. Thus, not only is it clear that Poppe fails to teach or suggest the broken cells, it is equally clear that Poppe does not provide any teaching, suggestion, or motivation that would lead to such a modification. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01.

Neither Contreras nor Giori teach or suggest the broken open cells of the present application. Thus, Poppe, Contreras, and Giori together fail to teach or suggest all the limitations of claim 1 of the present application.

Claim 2, which depends from claim 1, recites a method step for breaking open the cells in a foam sheet, “wherein the cells are broken open by pressing the foam together.” The Examiner states that “one skilled in the art would have appreciated that the cells would be broken open when the foam is bent and pressed together in the manner of Poppe.” Nothing in the Poppe patent teaches or suggests this, however. And, Poppe suggests no manner of pressing the foam together. Further, it is not at all clear that cells of a foam strip would be broken open simply when the foam is bent, as the Examiner suggests.

More importantly, because there is no teaching, suggestion, or motivation that would lead a modification of the Poppe foam spring by breaking open cells in the foam, it simply cannot follow that there can be any teaching, suggestion, or motivation to employ *any* method of breaking open the cells in a method of making the foam spring. The suggestion that “one skilled in the art would have appreciated that the cells would be broken open when the foam is bent and pressed together in the manner of Poppe” can only be reflective of a hindsight reading of the Poppe patent, armed with the teaching and motivation, derived only from the applicant’s disclosure in the present application and nowhere else, to break open the cells of the foam. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is respectfully submitted that, for at least these reasons, Poppe, Contreras, and Giori together fail to establish or support a prima case of obviousness of claims 1 and 2. It is respectfully submitted that claims 1 and 2, and the additional dependent claims 3-5, are allowable over the cited references. Withdrawal of the rejection is respectfully requested.

Conclusion

In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance.

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Art Unit: 1733

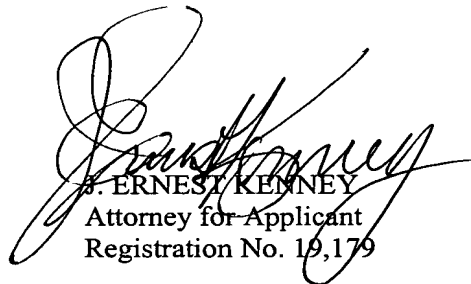
Accordingly, it is requested that claims 1-5 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's attorney, the Examiner is invited to contact the undersigned at the numbers shown.

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Respectfully submitted,



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